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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,704	08/30/2005	Gerd Dahms	4266-0106PUS1	9138
2292 7590 03/05/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
HOLT, ANDRIAE M				
ART UNIT		PAPER NUMBER		
1616				
NOTIFICATION DATE		DELIVERY MODE		
03/05/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

**Application No.**

10/517,704

**Applicant(s)**

DAHMS, GERD

**Examiner**

ANDRIAE M. HOLT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-25 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16, 22, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/06)  
Paper No(s)/Mail Date 12/13/2004 and 4/18/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group III, claims 17-21 and 23 in the reply filed on November 1, 2007 is acknowledged.

Claims 15-16, 22 and 24-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. The examiner acknowledges applicant's timely response to the election of species requirement in the reply filed on December 17, 2007.

Claims 17-21 and 23 are pending in this application. Claims 15-16, 22 and 24-25 have been cancelled.

### ***Priority***

Applicant's claim for the benefit of German Foreign Application 102262012 filed June 12, 2002 is acknowledged.

### ***Information Disclosure Statement***

Receipt of Information Disclosure Statements filed on December 13, 2004 and April 18, 2005 is acknowledged.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-20 and 23 are rejected under 35 U.S.C. 102(a) as being unpatentable over Mather et al. (WO 96/39119) in view of Nagashima et al. (JP 61215664).

### **Applicant's Invention**

Applicant claims an ether alcohol/polyol-in-oil emulsion comprising at least one ether alcohol of the general formula (I)  $R_1-O-[EO]_n H$  where  $R_1$  is C1-3-alkyl,  $n$  is on average 7 to 15, and EO is building blocks derived from ethylene oxide, in an oil-immiscible ether alcohol/polyol phase, an oil phase and at least one emulsifier. Applicant further claims that an cosmetic and/or pharmaceutical and/or agrochemical active ingredient is dissolved in the ether alcohol/polyol phase.

### **Determination of the scope of the content of the prior art (MPEP 2141.01):**

Mather et al. teach the invention relates to topical compositions containing azelaic acid and glycol and more particularly to new and improved compositions containing stabilized and completely solubilized azelaic acid (page 1, lines 7-10). Mather et al. further teach that another objective is to provide lower, yet effective concentrations of a topical azelaic acid formulation that is less likely to irritate the skin of the user (page 5, lines 5-7). Mather et al. teach that azelaic acid, a straight chain dicarboxylic acid with 9 carbons, has limited solubility in water and commonly used cosmetic oils. Mather et al. teach that low levels of azelaic acid may be completely dissolved in glycol from about 20% (w/w) to about 60% (w/w) (claim 20, 50 % weight, instant invention) and remain in stable solution (page 4, lines 20-25). Mather et al. teach that the glycol utilized may be

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one or more of the following, including methoxypolyethylene glycol (page 4, lines 25-28) (ether alcohol, methanol ethoxylate, claims 17 and 20, instant invention). Mather et al. teach on page 8, in example 3, lines 15-34, that an emulsion with commonly used cosmetic oils is made by mixing azelaic acid with dipropylene glycol and distilled water, which the mixture is then heated to 70° C until a clear solution results (claim 21, comprises a pharmaceutical active, instant invention). Mather further teaches that in a separate container C12-C15 benzoate, isododecane, cyclomethicone, stearyl alcohol (claim 17, emulsifier, instant invention), a commercial mixture of glyceryl stearate and PEG-100 stearate (ARLACEL 165) and a commercial mixture of isopropylparaben, isobutylparaben and butylparaben (LIQUAPAR OIL)(claim 17, oil, instant invention). Mather et al. teach that two this mixture the azelaic acid-dipropylene glycol-water mixture is added and the whole mixed while maintaining the temperature at 70° C. Mather et al. further teach the mixture is allowed to cool to 45° C.

**Difference between the prior art and the claims  
(MPEP 2141.02)**

Mather et al. do not teach the use of the ether alcohol of general formula (I) of the instant invention. It is for this reason Nagashima et al. is joined.

Nagashima et al. teach polyester-cellulosic blends were level-dyed with high dye buildup and color fastness and reproducibility using a dye batch containing 0.5 -30% water insoluble reactive disperse dye, 2.5-15% polyethylene glycol mono-Me ether as surfactant  $\text{C}_n\text{H}_{2n+2}\text{O}(\text{C}_2\text{H}_4\text{O})_m\text{C}_2\text{H}_5$  ..... (I) , where in the formula n designates

6-30(claims 17-19, formula (I), R1 is C1-2 alkyl and in is on average 8 to 15, methanol

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ethoxylate, instant invention) and carboxylate salt (page 2, Problems to be Solved). Nagashima et al. teach a dye dispersion was prepared from the dye I, lignosulfonic acid, ethylene glycol, and water. Nagashima et al. teach a water bath composition was prepared from the dispersion, heptaethylene glycol mono-Me ether,  $\text{C}_{12}\text{H}_{25}\text{O} + \text{C}_{12}\text{H}_{25}\text{O} \rightarrow \text{H}$ , a penetrating agent, a migration prevention agent, urea and aqueous BzONA to pH 7 and water (page 6, Practical example 1).

#### **Finding of obviousness/Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the two cited references to prepare an ether alcohol/polyol-in-oil emulsion because Mather et al. teach it is within the skill of one skilled in the art to use glycol derivatives, particularly, methoxypolyethylene glycol, to prepare emulsions containing a pharmaceutical agent. Nagashima et al. teach it is within the skill of one skilled in the art to use heptaethylene glycol mono-Me ether, the elected species as an effective surfactant in compositions that helps increase the uniformity and reproducibility of the compositions. One would have been motivated to make this combination in order to receive the expected benefit of an ether alcohol/polyol-in-oil emulsion that enhances the beneficial effects of a cosmetic, pharmaceutical or agrochemical active ingredient. It is widely known that non-ionic surfactants such as the heptaethylene glycol mono-Me ether as taught by Nagashima et al. are used to prepare emulsions. Given the state of the art as evidenced by the teachings of the cited references, and absent any evidence to the contrary, there would

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have been a reasonable expectation of success in combining the teachings of the cited references to prepare an emulsion that would provide the benefits of improved spreadability for agrochemical actives, increased activity of pharmaceutical actives, and decreased skin irritation and increased aesthetics, such as feel of cosmetic actives.

None of the claims are allowed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Klug et al. US Patent Application No. 2002/0136746.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDRIAE M. HOLT whose telephone number is (571)272-9328. The examiner can normally be reached on 7:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richter Johann can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHELLEY A. DODSON/  
Primary Examiner, Art Unit 1616

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